Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GREGORY W. GALE

Appeal No. 2001-1462
Application No. 09/306,516

ON BRIEF

Before ABRAMS, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 7-14. Claims 1-6, the only other claims pending in this application, stand allowed. As claim 8 stands rejected only under the doctrine of obviousness-type double patenting, the examiner having withdrawn the rejection of claim 8 under 35 U.S.C. § 103 on page 2 of the answer, and appellant has not appealed the obviousness-type double patenting rejection, as explained *infra*, claim 8 is not involved in this appeal. Accordingly, this appeal involves only claims 7 and 9-14.

BACKGROUND

The appellant's invention relates to a shipping carton for glass bottles and pulp inserts for use therewith (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

De Reamer	2,216,339	Oct. 1, 1940
Herrick et al. (Herrick)	2,547,005	Apr. 3, 1951
Watanabe et al. (Watanabe)	5,038,961	Aug. 13, 1991

The following rejections are before us for review.[1]

Claims 7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over De Reamer in view of Watanabe and Herrick.

Claims 10-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over De Reamer in view of Herrick.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 12) for the examiner's complete reasoning in support of the rejections

[1] Claims 7-14 also stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 7, 9 and 14 of U.S. Pat. No. 5,975,300, which issued on the parent Application No. 08/882,737 of the instant application. However, in that appellant has elected to file a terminal disclaimer rather than appeal this rejection, the double patenting rejection is not before us.

and to the brief and reply brief (Paper Nos. 9 and 13) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Turning first to the examiner's rejection of claims 10-14, we note that claim 10 recites a step of "***removably securing*** a half insert to each of the first and second bottom minor flaps" and claim 13 recites a step of "***removably securing*** a half insert to each of the first and second top minor flaps." Similarly, claim 14 recites "first and second half inserts formed of a non-plastic material and ***cooperative securing means removably securing*** said first and second half inserts to said first and second minor flaps" (emphasis ours).

As explained in appellant's specification from page 11, line 21, to page 12, line 34, the disclosed structure for removably securing the half inserts to the minor flaps includes the lock tabs 66, 67 in the flaps and the slots 126, 127 in the inserts.

Likewise, the disclosed acts for removably securing the half inserts to the minor flaps include the insertion of the lock tabs in the slots.

Consistent with appellant's underlying disclosure, one skilled in the art would understand the *removable* securement recited in claims 10, 13 and 14 to be one which permits the flaps and half inserts to be removed from one another with ease and without damage or alteration of the flaps and inserts. From our perspective, the skilled artisan would not recognize the adhesive attachments taught by De Reamer (page 3, left col., lines 38-53) and Herrick (col. 2, lines 19-22) as removable securements. Therefore, we share appellant's view (brief, pages 8, 9 and 10; reply brief, page 3) that De Reamer and Herrick, even if combined as proposed by the examiner, would not have suggested the subject matter of claims 10, 13 and 14. It follows that we shall not sustain the examiner's rejection of claims 10, 13 and 14, or claims 11 and 12 which depend from claim 10, as being unpatentable over De Reamer in view of Herrick.

In that the deficiency of the combination of De Reamer and Herrick finds no cure in the teachings of Watanabe, we also shall not sustain the examiner's rejection of claim 7, which also recites "cooperative securing means removably securing said first

and second half inserts to said first and second minor flaps," and claim 9, which depends from claim 7, as being unpatentable over De Reamer in view of Watanabe and Herrick.

REMAND TO THE EXAMINER

In an attempt to overcome the obviousness-type double patenting rejection, appellant filed a terminal disclaimer on February 26, 2001 (Paper No. 16).[2] There is no indication in the record that the examiner has notified appellant whether this terminal disclaimer is sufficient to overcome the rejection. Therefore, we remand this application to the examiner to inform appellant of the status of the terminal disclaimer and, hence, of the obviousness-type double patenting rejection.

[2] In an advisory action mailed on October 30, 2000 (Paper No. 11), the examiner explained to appellant that the terminal disclaimer filed September 28, 2000 (Paper No. 10) with the brief is improper because it is directed to specific claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 7-14 under 35 U.S.C. § 103 is reversed and the application is remanded to the examiner for the reason noted *supra*.

REVERSED AND REMANDED

NEAL E. ABRAMS Administrative Patent Judge	)	
JEFFREY V. NASE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

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